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P/3704-23



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:

Robert Barritz

Date: July 26, 2006

Serial No.: 09/829,894

Group Art Unit: 3625

Filed: April 10, 2001

Examiner: Robert E. Rhode, Jr.

For: AUTOMATED RETAIL WEBSITE CREATION

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF PURSUANT TO 37 C.F.R. §41.37

Sir:

This appeal is taken from the final action mailed January 26, 2006. In support of the Notice of Appeal filed May 26, 2006, the present Appeal Brief is presented.

I. REAL PARTY IN INTEREST:

The real party in interest in the above-identified application is: Treetop Ventures, LLC.

II. RELATED APPEALS AND INTERFERENCES:

There are no related appeals or interferences of which applicant is aware regarding the above-identified application.

III. STATUS OF CLAIMS:

Claim 1 stands rejected by the Examiner under 35 U.S.C. §112, second paragraph.

Claims 1-13 stand rejected by the Examiner under 35 U.S.C. §103(a).

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IV. STATUS OF AMENDMENTS:

A response to the final rejection was submitted, only minor amendments were made to the claims to replace the claim term, “semi-automatically” with “substantially automatically.” Further, an obvious, minor typographical error in claims 3, 8 and 10 were corrected by amendment.

V. SUMMARY OF CLAIMED SUBJECT MATTER:

Independent claim 1 recites a “website constructor” that includes a “selection criteria module,” which establishes a selection criteria for merchandise selection (see, for example, page 6, lines 21-24, page 17, lines 14-20 and page 18, lines 1-6 and Fig. 4, step 14). Another module of the website constructor is a “website organization module” that is operable to define a “look and feel” of a website constructed by the website constructor (see, for example, page 8, lines 1-6, page 9, lines 16-25 and Fig. 4, step 16).

The website constructor further includes a “graphic design module” that creates at least one website layout and features setup for the website (see, for example, page 10 lines 4-16 and Fig. 4, step 18). Moreover, a “merchandise selection module” is included in the website constructor that “selects merchandise offered for sale on the website ... that matches the selection criteria at least substantially automatically” (see, for example, page 10, line 21 - page 11, line 18 and Fig. 4, step 20).

The website constructor further includes a “merchandise information downloading module” operable to download substantially automatically, from a plurality of vendors of merchandise, merchandise information defining the merchandise offered for sale on the website ... that has been selected by the merchandise selection module” (see, for example, page 11, line 22 - 30 and Fig. 4, step 22). Further, a “website builder” is provided that “builds the website based on the criteria and conditions that have been setup by the foregoing modules” (see, for example, page 13, line 2-page 14, line 4 and Fig. 4, step 24).

Claims 2-13 depend directly or indirectly from claim 1, and include additional patentable features.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL:

The following grounds of rejection are presented for review:

1. Whether claim 1 is unpatentable under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Whether claims 1-13 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over Bernardo et al. (“Bernardo,” U.S. Patent No. 6,684,369) in view of Saroja Girishankar (“Catalog,” “Build the e-commerce catalog”).

VII. ARGUMENT:

Rejection Under 35 U.S.C. §112, Second Paragraph

Claim 1 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 1 is rejected under 35 U.S.C. §112, second paragraph on the grounds that the word “criteria” is not defined by the claims, and the words “substantially automatically” are similarly not defined by the claims. Applicant respectfully disagrees.

Computers perform no tasks without instructions. Automating processes to reduce a required level of user skill as well as to reduce the number of steps required of a user has been the goal of computer programmers and software developers for decades. A person of ordinary skill in the art recognizes that some action, typically on the part of the user, may occur once or repeatedly in order for other programmed instructions to execute automatically. Thus, one of ordinary skill recognizes that “substantially automatically” means that it is overwhelmingly more likely that a process or feature of the invention will occur without or with minimal manual input from a user.

The present invention, as defined by the claims, enables the creation of retailer websites and the like in a substantially automated fashion, and streamlines and greatly facilitates the creation of such websites (see applicant’s written description, page 17). Of course, some user activity may be initially required once, such as a selection of a background color for a website, and thereafter tasks are performed automatically. To define such a task as “automatic” would be

inaccurate since an initial, non-automatic step (i.e., the selection of the background color) was performed.

Applicant has carefully reviewed the May 18, 2006 Advisory Action received in connection with the present patent application. Respectfully, applicant disagrees with the Examiner's conclusion that "one of ordinary skill can only speculate what the phrase 'substantially automatically' means and it is not possible to establish the metes and bounds of these claims[.]"

Pursuant to MPEP §2111.01 II, applicant submits that "the ordinary and customary meaning" of "substantially automatically" is the "meaning that the term would have to a person of ordinary skill in question at the time of the invention[.]" Moreover, citing *Phillips v. AWH Corp.*, 75 USPQ2d 1321 (Fed. Cir. 2005), MPEP §2111.01 II states "[i]n the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art." Further, "[i]t is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning the terms of the claims (citing *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338 (Fed. Cir. 2003)). Applicant submits that the claim term, "substantially automatically" falls clearly within MPEP §2111.01 II and takes on the ordinary and customary meanings attributed to them by those of ordinary skill in the art.

Applicant is not expressly or implicitly intending to impart any novel meaning to the term, "substantially automatically." Applicant cites to pages 6, 16, 17 of applicant's written description that includes the term, "substantially automatically," in the context of website creation, merchandise selection and website building. Accordingly, one skilled in art would understand, in the context of the written description, drawings and claims, the ordinary and customary meaning of "substantially automatically. The Examiner improperly concludes that no such ordinary and customary meaning exists.

Moreover, the Examiner improperly dismisses numerous issued patent claims as not "precedential" and cites to no authority for support. However, the Examiner qualifies that such claims are "particularly" not precedential "if these phrases were well defined in the disclosure [of the issued patents]." Applicant disagrees, and calls to the Examiner's attention, for example,

U.S. Patent No. 5,878,418, which includes twenty four claims that include the term “substantially automatically,” and which includes no definition of the term in the specification.

Further, the Court of Appeals for the Federal Circuit has held that claim language, such as use of the term, “substantially automatically,” can “accommodate minor variations that may be appropriate to secure the invention.” See, for example, *Verve LLC v. Crane Cams Inc.*, 65 USPQ2D 1051, 1054, U.S. Court of Appeals (Fed. Cir. 2002), quoting *Pall Corp. v. Micron Separations, Inc.*, 36 USPQ2D 1225, 1229 (Fed. Cir. 1995). Applicant maintains that the term, “substantially automatically,” is a descriptive term that is commonly used in patent claims and avoids a “strict ... boundary to [a] specified parameter.” *Verve LLC v. Crane Cams Inc.* at 1054. One skilled in the art would understand that substantially automatically means, generally, it is overwhelmingly more likely that a process or feature of the invention will occur without or with minimal manual input from a user.

In the Office Action, at page 3, first full paragraph, the Examiner states that, “[f]or examination purposes the word ... ‘substantially automatically’ will be treated as a search criteria being entered each time for each separate item/merchandise by an individual such as a business owner.” Applicant respectfully but strenuously disagrees with this overly narrow and restrictive construction. As noted in applicant’s written description, for example, at page 14, lines 25 - page 15, line 7, merchandise can be added or removed “automatically, when [the website constructor] detects” one or more predefined conditions, such as when a vendor has changed merchandise characteristics. Therefore, the term, “substantially automatically,” should not be interpreted as requiring an individual entering item/merchandise search criteria each time a search is made.

With respect to the term, “criteria,” applicant respectfully submits that the specification is replete with the use of “criteria,” and that “selection criteria” relates to merchandise selection. As explained by example at page 7, lines 1-19 in the written description of applicant’s application, such criteria can be one or more of category, sub-category, manufacturer, vendor, promotions, and starting and ending dates. One skilled in the art would be able to determine that “selection criteria” as used in the claims means such factors to select merchandise. Therefore, applicant maintains that use of the term, “selection criteria” does not render claim 1 indefinite, under 35 U.S.C. §112. See, for example, *GMIS Inc v. Health Payment Review, Inc.*, 34 USPQ2d 1389 (E.D.PA, 1995) (holding that use of the claim term “non-medical criteria” is not indefinite).

Rejection Under 35 U.S.C. §103(a)

Claims 1-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bernardo et al. (“Bernardo,” U.S. Patent No. 6,684,369) in view of Saroja Girishankar (“Catalog,” “Build the e-commerce catalog”).

As noted above, a single website constructor comprising the selection criteria module, the website organization module, the graphic design module, the merchandise selection module, the merchandise information downloading module and the website builder, operates to build a website based on criteria and conditions set up thereby. The combination of elements defined in Applicant’s claim 1 is not taught or suggested by Bernardo, Catalog, or both references combined.

Bernardo describes a fairly typical prior art web site creation tool that essentially applies pre-defined HTML templates to enable a user to build internet web sites (see Abstract). The user is prompted to select features and options desired for the web site and to supply information corresponding to the selected features, and the tool builds the web site from the pre-stored HTML templates and supplied data from the user.

As noted by the Examiner, Bernardo is silent with respect to applicant’s claim 1 “selection criteria [module]”, “merchandise selection [module]”, and “merchandise information downloading [module]”. Accordingly, applicant respectfully disagrees with the Examiner that Bernardo teaches applicant’s claim 1 “website builder” because claim 1 defines that the “website builder” builds a website based on the criteria and conditions that have been setup by the “selection criteria module,” the “website organization module,” the “graphic design module,” the “merchandise selection module” and the “merchandise information downloading module” (i.e., the “foregoing modules”). Bernardo does not teach or suggest these features, and thus cannot teach or suggest applicant’s claim 1 “website builder.”

Catalog is cited for providing elements of applicant’s claim 1 that the Examiner believes are missing from the teachings of Bernardo. In particular, Catalog is cited for applicant’s “selection criteria [module],” “merchandise selection [module],” and “merchandise information downloading [module],” all of which the Examiner concludes are included in a “website constructor” taught by Catalog. Applicant respectfully disagrees.

Catalog describes the evolution of e-procurement and comparison shopping systems that incorporate uniform Extensible Markup Language (“XML”) data. Using XML tags, data can be categorized using well-known and used terms, thereby simplifying the process associated with procurement. Catalog describes prior art data management tools, such as described in applicant’s written description, particularly in the section devoted to describing the background of the invention.

Applicant respectfully submits that Catalog does not teach or suggest the elements of applicant’s claim 1 that are missing from the teachings of Bernardo. Catalog regards receiving data from a plurality of disparate sources and “cleansing” the data in a uniform way, particularly for comparison shopping. Catalog is silent with respect to applicant’s claim 1 combined “selection criteria module,” “merchandise selection module” and “merchandise information downloading module.” Further, Catalog is silent with managing data, and in particular with respect to building a website based on the criteria and conditions that have been setup by applicant’s claim 1 modules. Instead, Catalog regards data management, and merely mentions, for example, using the data in an organization’s enterprise resource planning system (see, for example, Catalog, page 6, lines 1-3).

Applicant submits that the Examiner’s efforts to combine Bernardo with Catalog are based upon hindsight and the teachings of applicant’s invention. Without the benefits of applicant’s disclosure, one skilled in the art would not be motivated to combine the references as the Examiner has done. Catalog is not directed to website building, but instead to comparison shopping and data management. Bernardo is not directed to data management, but is, instead, directed to editing a web site using a graphical editor.

Even if one were to combine the references as the Examiner has done, applicant’s invention still is not taught. The resulting combination is not a website constructor that comprises all of the modules, including a selection criteria module, a website organization module, a graphic design module, a merchandise selection module, a merchandise information downloading module and a website builder. There is no linking component between the prior art web site graphical editor disclosed in Bernardo and the plurality of data managing tools (e.g., directed to on-line catalogs and comparison shopping) disclosed in Catalog. Therefore, the

combination of modules defined in applicant's claim 1 is not disclosed in the combined teachings of Bernardo and Catalog.

For the foregoing reasons, applicant respectfully submits that the neither Bernardo nor Catalog, taken alone or in combination, teach or suggest the features defined in applicant's claim 1.

Claims 2-13 depend directly or indirectly from claim 1 and are, therefore, patentable for the same reasons, as well as because of the combination of features in those claims with the features set forth in the claim(s) from which they depend.

VIII. CONCLUSION:

For the reasons set forth above, it is respectfully submitted that claim 1 and all its dependent claims clearly define over the prior art. Therefore, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

Check No. 25371 in the amount of \$250.00 (small entity) to cover the fee for filing an Appeal Brief is enclosed. Any additional fees or charges required at this time in connection with this application may be charged to Patent and Trademark Office Deposit Account No. 15-0700.

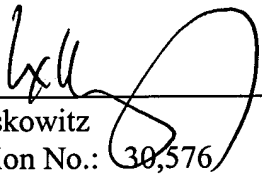
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Max Moskowitz
Name of applicant, assignee or
Registered Representative

Signature

July 26, 2006
Date of Signature

Respectfully submitted,



Max Moskowitz
Registration No.: 30,576
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700

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CLAIMS APPENDIX

1. A website constructor, comprising:
 - a selection criteria module that establishes a selection criteria for merchandise selection;
 - a website organization module that defines a look and feel of a website constructed by the website constructor;
 - a graphic design module that creates at least one website layout and features setup for the website constructed by the website constructor;
 - a merchandise selection module in the website constructor that selects merchandise offered for sale on the website constructed by the website constructor that matches the selection criteria at least substantially automatically, the merchandise selection module being based on merchandise made available by a plurality of vendors;
 - a merchandise information downloading module that downloads substantially automatically, from a plurality of vendors of merchandise, merchandise information defining the merchandise offered for sale on the website constructed by the website constructor that has been selected by the merchandise selection module; and
 - a website builder that builds the website based on the criteria and conditions that have been setup by the foregoing modules.

2. The website constructor of claim 1, wherein the constructor is operable substantially automatically.

3. The website constructor of claim 1, in which the website is optimized for a retail operation.

4. The website constructor of claim 1, in which merchandise information comprises at least two of the following merchandise parameters that are selected from the group consisting of: product code, UPC code, SKU code, product description, retail price, product style, product color, product size, product ordering information, product incentive program, product image, and product tags.

5. The website constructor of claim 4, in which the merchandise information is provided in Extensible Markup Languages (XML).

6. The website constructor of claim 1, in which the selection criteria comprises at least two parameters selected from the parameter group consisting of: category; subcategory; manufacturer; vendor; promotions; close-out; starting date and ending date of seasonal merchandise.

7. The website constructor of claim 1, in which the website organization module defines the look and feel of the website by reference to one or more organization parameters selected from the parameter group consisting of: category; manufacturer; promotions; close-out; product appearance; and tags representing the begin and end dates for the placement of merchandise on the website.

8. The website constructor of claim 1, in which the merchandise selection module enables a user of the website constructor to control downloading of merchandise information in a manner which enables: acceptance or rejection of marketing or merchandise information based on the selection criteria; selection of purchase orders, pricing schedules, and delivery schedules; and specification of loading information.

9. The website constructor of claim 1, in which the website builder enables periodical rebuilding of the website.

10. The website constructor of claim 1, in which the website builder enables rebuilding of the website based on the detection of a changed condition.

11. The website constructor of claim 10, in which the changed condition comprises a change in a date.

12. The website constructor of claim 10, in which the changed condition comprises the changing of the merchandise information by a vendor.

13. The website constructor of claim 10, in which the changed condition constitutes a manual intervention by a user of the website constructor.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.